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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,752	03/26/2001	Olga Bandman	PF-0559 USN	7326

7590 08/26/2003  
Incyte Genomics Inc  
Legal Department  
3160 Porter Drive  
Palo Alto, CA 94304

EXAMINER

HADDAD, MAHER M

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 08/26/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/743,752

Applicant(s)

BANDMAN ET AL.

Examiner

Maher M. Haddad

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 April 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

2. In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 1-2 and 13, drawn to a substantially purified polypeptide comprising an amino acid sequence of SEQ ID NO:1, a fragment of SEQ ID NO:1 and a pharmaceutical composition thereof.
- II. Claims 1-2 and 13, drawn to a substantially purified polypeptide comprising an amino acid sequence of SEQ ID NO:2, a fragment of SEQ ID NO:2 and a pharmaceutical composition thereof.
- III. Claims 3-12, drawn to a polypeptide of SEQ ID NO:3 encoding SEQ ID NO:1, an expression vector, a host cell and a method of producing the polypeptide.
- IV. Claims 3-12, drawn to a polypeptide of SEQ ID NO:4 encoding SEQ ID NO:2, an expression vector, a host cell and a method of producing the polypeptide.
- V. Claims 14 and 16, drawn to a purified antibody which specifically binds to the polypeptide of SEQ ID NO:1 and a purified antagonist of the polypeptide of SEQ ID NO:1.
- VI. Claims 14 and 16, drawn to a purified antibody which specifically binds to the polypeptide of SEQ ID NO:2 and a purified antagonist of the polypeptide of SEQ ID NO:2.
- VII. Claim 15, drawn to a purified agonist of the polypeptide of SEQ ID NO:1.
- VIII. Claim 15, drawn to a purified agonist of the polypeptide of SEQ ID NO:2.
- IX. Claim 17, drawn to a method for treating or preventing a cell proliferative disorder comprising administering a composition comprising SEQ ID NO:1.
- X. Claim 17, drawn to a method for treating or preventing a cell proliferative disorder comprising administering a composition comprising SEQ ID NO:2.
- XI. Claim 18, drawn to a method for treating or preventing an immune disorder comprising administering a composition comprising SEQ ID NO:1.

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- XII. Claim 18, drawn to a method for treating or preventing an immune disorder comprising administering a composition comprising SEQ ID NO:2.
- XIII. Claims 19-20, drawn to a method for detecting a polynucleotide encoding the polypeptide comprising the amino acid sequence of SEQ ID NO:1 or fragment of SEQ ID NO:1.
- XIV. Claims 19-20, drawn to a method for detecting a polynucleotide encoding the polypeptide comprising the amino acid sequence of SEQ ID NO:2 or fragment of SEQ ID NO:2.

2. The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The invention of Claim 9 was found to have no special technical feature that defined the contribution over the prior art of NCI-CGAP (GenBank Accession No. AI147591, 1998).

NCI-CGAP teaches a 378 polynucleotide sequence which is 100% complementary to the polynucleotide sequence of a fragment of SEQ ID NO:3 at positions (NA 894-1271) (see attached sequence alignment).

Since Applicant's inventions do not contribute a special technical feature when viewed over the prior art they do not have a single general inventive concept and so lack unity of invention.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maher Haddad, whose telephone number is (703) 306-3472. The examiner can normally be reached Monday to Friday from 8:00 to 4:30. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached at (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 872-9307.

Maher Haddad, Ph.D.  
Patent Examiner  
Technology Center 1600  
August 25, 2003

  
CHRISTINA CHAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600